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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,875	08/22/2003	Dante Monteverde	35041/400300	1874
27717	7590	11/07/2006	EXAMINER	
SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE2400 CHICAGO, IL 60603-5803			ZAND, KAMBIZ	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/604,875	Applicant(s) MONTEVERDE, DANTE	
	Examiner Kambiz Zand	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/22/3003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/02/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1-45** have been examined.

Information Disclosure Statement PTO-1449

2. The Information Disclosure Statement submitted by applicant on 07/20/2005 has been considered. Please see attached PTO-1449.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-28 and 30-45** are rejected under 35 U.S.C. 101 because the claims have no tangible embodiment or useful result in a tangible embodiment (one may have a result, but what such result is for that determines the usefulness and concreteness of such result) is disclosed. The above claims only disclose software not embodied in any tangible embodiments, the result of the above independent claims only represent analysis of mathematical manipulation that does not transform a physical transformation having a concrete and tangible result. See *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (1966).

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Examiner notes: Claim 16 only needs transmission of the communication from tangible embodiments to the internet user through a network utilizing internet.

Claim 30 is the broadest and is not clear what is the usefulness of the result created since it does not even communicate such result to any entity and do anything with it, therefore the question of tangible embodiment and the usefulness of the result as a concrete result is also lacking. Claim 1 lacks tangible embodiment for such method and communication of a useful result from a tangible embodiment to an internet user using tangible embodiment of a network utilizing the internet. The usefulness is the result that tie "trustworthiness of an internet site" with such result should be enclosed in the body of the claim at the end in a tangible embodiment and the transmission of it to the user for usefulness of it is the key for overcoming the 101 rejection, since it would have a tangible, useful concrete result for decision making of the user of the internet with respect to the concern site.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. **Claims 4-13, 19 and 34-43** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

7. **Claim 4, 19 and 34** disclose a step that is based on "if" limitation which means if the internet site does not complies with the criterion, then the limitations of claims 4 and 34, and subsequently their dependent claims 5-13 and 35-43 do not have to be addressed which makes the claims indefinite since the essential step of addressing the alternative step of non-compliance is not present in the claim language to give the full and clear meaning to the claims 4 and 34. Examiner suggest adding such steps or elimination of the "if" statement from the claim language. Claims 4-13 and 35-43 are rejected based on their dependency on the rejected claim above and because would not correct the deficiencies related to the claims 4 and 34 above.

8. **Claims 2-15, 17-28, and 31-45** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. **In claims 4, 24, 38** the limitation "privacy statement" is relative term, makes the claims indefinite since a statement with respect to it's "privacy" does not have a standard uniform definition and "privacy" statement to one entity may be different from "privacy" statement of another entity with respect to what those entity consider as "privacy".

10. **In claim 12**, the limitation "popularity" is relative term, makes the claims indefinite since a statement with respect to it's "popularity" does not have a standard uniform definition and "popularity" from one entity may be different than another entity.

11. **In claims 2-15, 17-28 and 31-45**, the "wherein.." phrases makes the claims indefinite and unclear in that neither method steps nor interrelationship of method steps

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are set forth in these claims in order to achieve the desired results expressed in the "wherein..." phrases.

Double Patenting

12. **Claims 31, 32, 33, 44, and 45** are objected to under 37 CFR 1.75 as being a **substantial duplicate of claims 1, 2, 3, 14 and 15** respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. **Claims 1, 16, 29 and 34** are rejected under 35 U.S.C. 102(e) as being anticipated by Underwood (6,523,027).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as

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potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 1, 30 and 31 Underwood (6,523,027) teach a method of anticipating the trustworthiness of an Internet site having content comprising dynamically analyzing the content to assess an amount of criteria the content complies with (see fig.) thereby creating an analytical result and communicating to an Internet user the analytical result (see fig.1-26; fig.91-101 and associated texts based on the broadness of the claim where objects or events corresponds to applicant's content criteria). Examiner notes that the limitation "anticipating the trustworthiness of an Internet is in preamble of the claim and not body of the claim. The body of the claim by itself is self clear not relying of the above limitation in the preamble of the claim.

As per claims 2, 17 and 32 Underwood (6,523,027) teach the method as claimed in claims 1, 31 respectively wherein the analytical result includes a numerical representation of the trustworthiness of the Internet site (fig.121-129 and associated text where the events represents a value which is numerical).

As per claims 3, 20 and 33 Underwood (6,523,027) teach the method as claimed in claims 1 and 31 respectively wherein the analytical result includes a scaled gauge representation of the trustworthiness of the Internet site (see fig.121-129 and associated text).

As per claims 4, and 19 Underwood (6,523,027) teach the method as claimed in

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claims 2, 18 respectively wherein the criteria respectively includes numerical points wherein each criterion awards a number of points to the Internet site if the Internet site complies with the criterion (see fig.1-26 and associated texts).

As per claims 13, and 32 Underwood (6,523,027) teach the method as claimed in claims 1, 31 wherein the analytical result is communicated to the Internet user independently of the Internet site (see fig.32 and associated text).

As per claim 14 and 44 Underwood (6,523,027) teach the method as claimed in claims 14, 43 respectively wherein the analytical result is displayed within a tool bar incorporated into an Internet browser (see fig. 19, 42 and associated texts).

As per claims 16 and 29 Underwood (6,523,027) teach a system, a method of displaying the anticipated trustworthiness of an Internet site having content displayed in an Internet browser to an Internet user comprising: providing an Internet browser add-on capable of communicating to the Internet user an analytical result representing the anticipated trustworthiness of the Internet site displayed in the Internet browser; dynamically analyzing the content to assess the trustworthiness of the Internet site thereby defining the analytical result; and communicating to the Internet user the analytical result (see fig.1-26; fig.91-101 and associated texts).

As per claim 18 Underwood (6,523,027) teach the method as claimed in claim 16

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wherein the step of dynamically analyzing the content to assess the trustworthiness of the Internet site thereby defining the analytical result includes determining an amount of criteria the content meets (see fig.1-26; fig.91-101 and associated texts).

As per claim 20 Underwood (6,523,027) teach the method as claimed in claim 18 wherein the analytical result includes a scaled gauge representation of the trustworthiness of the Internet site (see fig.1-26, 91-101 and 145-146 and associated texts).

As per claim 21 Underwood (6,523,027) teach the method as claimed in claim 18 wherein the criteria includes determining if an electronic mail address is present in the content (see fig.23-24 and associated text; text title "even monitoring" and "conclusion").

As per claim 22 Underwood (6,523,027) teach the method as claimed in claim 18 wherein the criteria includes determining if a postal address is present in the content (see fig.145 and associated text with respect to business model and examples given).

As per claim 23 Underwood (6,523,027) teach the method as claimed in claim 18 wherein the criteria includes determining if a telephone number is present in the content (see fig.51 & 145 and associated text).

As per claim 24 Underwood (6,523,027) teach the method as claimed in claim 18

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wherein the criteria includes determining if privacy statement is present in the content (see and fig. And text with respect to billing where examiner considers such statement corresponds to applicant "privacy" statement).

As per claim 25 Underwood (6,523,027) teach the method as claimed in claim 18

wherein the criteria includes determining if the Internet site supports secure Internet transactions (see fig.16 a-b and associated text; fig.1d-e and associated text).

As per claim 26 Underwood (6,523,027) teach the method as claimed in claim 18

wherein the criteria includes determining if the Internet site has a verified authentication certificate (see fig.16 a-b and associated text).

As per claim 27 Underwood (6,523,027) teach the method as claimed in claim 18

wherein the criteria includes determining a traffic ranking of the Internet site (see fig.16-22 and associated texts, examiner considers the events determinations as corresponding to applicant's traffic).

As per claim 28 Underwood (6,523,027) teach the method as claimed in claim 18

wherein the criteria includes determining if the Internet site is validated by an independent third party validating service (see fig.26-50 and associated text where the third entity validate services rendered or requested by a user).

Allowable Subject Matter

15. **Claims 4-13, 19, and 34-43**, could be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 and 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: please see enclosed PTO-892.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned are (571)-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

11/05/2006

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PRIMARY EXAMINER